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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,574	11/24/2003	Lewis Michael Popplewell	IFF-36-2	5713
48080	7590	07/18/2005	EXAMINER	
INTERNATIONAL FLAVORS & FRAGRANCES INC. 521 WEST 57TH ST NEW YORK, NY 10019			HARDEE, JOHN R	
			ART UNIT	PAPER NUMBER
			1751	
DATE MAILED: 07/18/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/720,574

Applicant(s)

POPPLEWELL ET. AL.

Examiner

John R. Hardee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date (2).
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. Applicant has submitted approximately **250** references for the examiner's consideration in the Information Disclosure Statements filed May 10, 2004 and March 21, 2005. Of these, numerous references, such as Trinh '315, CRC Handbook, '404, Sebag '423 and '755, do not appear particularly pertinent to the instant claims. It is unclear why these were cited because they do not appear to be "material to patentability" of the claimed invention (37 CFR 1.56). Parekh applications '888 and '239 are likewise not particularly pertinent, while applications containing the same claims ***verbatim*** as those presently presented are not listed (see double patenting rejections below).

MPEP 2004, particularly paragraph (13), sets forth guidelines to aid applicants in their duty of disclosure. In this section it is stated:

"It is desirable to avoid submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant or marginally pertinent cumulative information. If a long list is submitted, highlight those documents, which have been specifically brought to the applicant's attention and/or are known to be of most significance. See *Penn Yan Boats, Inc., v. Sea Lark Boats, Inc.*, 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), *aff'd*, 479 2d 1388, 178 USPQ 577 (5th Cir. 1973), *cert. denied* 414 U.S. 874 (1974)."

The examiner requests that applicant provide a list of the 3-5 most pertinent references and their relevance to the presently claimed invention.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

1. Claims 1-8 and 11-19 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-8 and 11-19 of copending Application No.

10/460,010. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

2. Claims 1-8 and 11-14 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1-8 and 11-14 of copending Application No.

10/268,566. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 9 and 10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9 and 10 of copending Application No. 10/460,010. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are identical except that the present claim 9 recites polymers which are not recited in claim 9 of the '010. Accordingly, the claims anticipate each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 9 and 10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9 and 10 of copending Application No. 10/268,566. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are identical except that the present claim 9 recites polymers which are not recited in claim 9 of the '566. Accordingly, the claims anticipate each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/720,572. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '572 recites particles

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comprising a perfume encapsulated in a polymer which is further encapsulated in a polyamine, which is taught by applicant to be a cationic polymer. Dependent claims recite specific polyamines and crosslinking agents. Accordingly, the claims anticipate the present claims. Anticipation is the epitome of obviousness.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/460,434. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '434 recites compositions comprising silicone and a polymer-encapsulated fragrance which is further encapsulated by a cationic polymer. While the specific polymers of the present claims are not recited, they are well known polymers for encapsulation of perfume, and their use would be obvious in the absence of unexpected results. Accordingly, it would have been obvious at the time that the invention was made to make particles as presently recited, because the '434 claims compositions as summarized above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/268,526. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '526 recites particles

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comprising a perfume encapsulated in a polymer which is further encapsulated in a polyamine, which is taught by applicant to be a cationic polymer. Dependent claims recite specific polyamines and crosslinking agents. Accordingly, the claims anticipate the present claims. Anticipation is the epitome of obviousness.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-7, 11, 12, 14-16 and 19 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Shefer et al., US 6,740,631. See Example 2. The polyethyleneimine charge booster is a cationic polymer. The cationic fabric conditioning agent meets the limitations of claims 15 and 19. Applicant's statements of intended use do not define the claims over the reference.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 1-9 and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shefer et al., US 6,740,631. See the 102 rejection above. The reference discloses delivery systems for encapsulated ingredients, such as fragrances which are

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encapsulated into nanospheres which are in turn encapsulated into microspheres. A cationic fabric conditioning agent may be encapsulated within the nanosphere, and a cationic charge booster in the microsphere matrix (abstract). Suitable materials for forming the nanospheres include polyvinylpyrrolidines and ethylene-acrylic acid copolymers (col. 15, lines 58+). Suitable matrix materials for the microspheres include cationic polymers with dimethylaminoethylammonium functionality and starch derivatives (col. 16, lines 24+). The examiner takes the position that the person of ordinary skill in the art could fairly infer the utility of cationic polysaccharides generally from this disclosure. Cationic charge boosters, including polyvinylamines and polyethyleneimine, may be incorporated into the microsphere matrix (col. 9, lines 45+). The conditioning agent may comprise silicone (col. 14, lines 8+). This reference differs from the claimed subject matter in that it does not disclose a composition which reads on all of applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a fragrance and fabric softening composition which is encapsulated by a polymer and further encapsulated by a cationic polymer. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257,

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191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed Cir. 1990).

15. Claims 1-9 and 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ness et al., US 6,024,943. The reference discloses particles containing absorbed liquids and methods of making them. Perfume is absorbed within a n organic polymer particle which has a further polymer, which incorporates free hydroxyl groups, at its exterior. The further particle may be part of an encapsulating shell (abstract). The preferred outer polymer is polyvinyl alcohol (col. 3, line 10). The vinyl acetate from which the polyvinyl alcohol is formed may be copolymerized with vinyl formamide. Hydrolysis of the copolymer affords a cationic polyvinyl acetate-polyvinyl amine copolymer (col. 3, lines 23+). The core particle may comprise vinyl monomers, including acrylic acid esters and alkylacrylic acid, as well as styrene (col. 3, lines 59+). Core particles absorb a quarter to ten times their weight in perfume, and the ratio of perfume to outer shell is 1:30 to 1:1, so the limitations of claim 4 can be met by following the teachings of the reference. Fabric detergent compositions according to the invention comprise at least 5-10% of detergent active. Detergent compositions may further comprise antifoam agents, which commonly comprise silicones (col. 9, line 55). Fabric conditioners (col. 10, lines 4+) ad wash-off compositions (col. 13, lines 53) which incorporate the particles are disclosed. As calcium chloride is not disclosed as a mandatory constituent, it would be obvious to omit it. +). This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a fragrance and fabric softening composition which is encapsulated by a polymer and further encapsulated by a cationic polymer. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed Cir. 1990).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (571) 272-1318. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (571) 272-1316.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "J. Hardee", with a stylized flourish at the end.

John R. Hardee

Primary Examiner

July 13, 2005